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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,768	11/30/2001	Hideo Suzuki	393032001901	2094

25224 7590 09/02/2003

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EXAMINER	
FLETCHER, MARLON T	
ART UNIT	PAPER NUMBER
2837	

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/008,768	SUZUKI ET AL.	
	Examiner	Art Unit	
	Marlon T Fletcher	2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 November 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *08/977,727* .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 16 and 21-23 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 34 and 36-38 of prior U.S. Patent No. 6,452,082. This is a double patenting rejection.

Claim 16 of the present application has the identical limitations of claim 37 of the patent '082.

Claim 21 of the present application has the identical limitations of claim 34 of the patent '082.

Claim 22 of the present application has the identical limitations of claim 36 of the patent '082.

Claim 23 of the present application has the identical limitations of claim 38 of the patent '082.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of U.S. Patent No. 6,452,082. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter is the same in both claims, wherein the receiving and storing require the same, wherein storage requires reception; and wherein selecting and designating are the same. Both claim recite the step of forming musical tone data. The only difference lies in the choice of words for the claims. The same subject matter of the present claim is found in the patent claim.

It would have been obvious to one of ordinary skill in the art to provide the same subject matter in view of the patent claim, wherein the storing requires reception of data and designating and selecting are the same.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 14-17 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Serra et al. (5,536,902).

As recited in claim 14, Serra et al. disclose a method of processing musical performance data, comprising the steps of: receiving via input (12) a sequence of pieces of musical performance data represented by a sequence of musical notes; designating via interface (15) a performance method for each of the received pieces of musical performance data by a player in real time; and forming musical tone data by attaching performance method data indicative of the designated performance method to said each of the received pieces of musical performance data (column 13, lines 39-51 and column 14, lines 51-60).

As recited in claim 15, Serra et al. disclose a method, wherein said designation is made by a user (column 9, lines 21-33 and column 14, lines 51-60).

As recited in claim 16, Serra et al. disclose a method of forming musical tone waveform data, comprising the steps of: reproducing musical performance data (column 13, lines 29-33); generating performance method data indicative of a performance method as the reproduction of said musical performance data (column 13, lines 39-48); and forming musical tone waveform data based on said musical performance data and said performance method data (column 13, lines 48-51).

As recited in claims 17 and 24, Serra et al. disclose a method, wherein said generation of performance method data is carried out based on a performance method designated by a player in real time, and said formation of musical tone waveform data is

carried out by attaching said performance method data to said musical performance data (column 9, lines 7-17 and column 14, lines 56-61).

As recited in claim 21, Serra et al. disclose a method of making a medium which stores data prepared using the steps of: analyzing (analysis 10) a progression manner of at least one note in musical performance data; decomposing said musical performance data into a plurality of pieces according to results of said analyzing (column 10, lines 3-56); determining a performance method for each of said plurality of pieces, which is to be applied in performing each of said. plurality of pieces (column 12, lines 29-54); providing a storage medium (100); and storing data representative of said determined performance method for each of said plurality of pieces in the storage medium (column 10, lines 57-60).

As recited in claim 22, Serra et al. disclose a method of making a medium which stores data prepared using the steps of: selecting tone color data for musical performance data (column 8, lines 44-47); analyzing (10) at least one piece of said musical performance data in a manner corresponding to the selected tone color data; forming musical tone data by attaching performance method data indicative of a performance method corresponding to a result of said analyzing to said musical performance data (column 13, lines 39-51 and column 14, lines 51-60); providing a storage medium (100); and storing data representative of said formed musical tone data in the storage medium (column 10, lines 57-60).

As recited in claim 23, Serra et al. disclose a method of making a medium which stores data prepared using the steps of: reproducing musical performance data

(column 13, lines 29-33); generating performance method data indicative of a performance method during the reproduction of said musical performance data (column 13, lines 39-48); forming musical tone waveform data based on said musical performance data and said performance method data (column 13, lines 48-51); providing a storage medium (100); and storing data representative of said formed musical tone waveform data in the storage medium (column 10, lines 57-60).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serra et al. in view of Kellogg et al. (4,930,390) and Kakishita et al. (5,591,930).

As recited in claim 18, Serra et al. disclose a method of generating musical tones, comprising the steps of: selecting at least one tone color for a musical piece (column 8, lines 44-47); and generating musical tones in accordance with the selected performance method (column 13, lines 39-51).

As recited in claim 19, Serra et al. disclose a method, wherein said selection is made by a user (column 9, lines 21-33 and column 14, lines 51-60).

As recited in claim 20, Serra et al. disclose a method, wherein a desired performance method is selected from the displayed performance methods by using a switch (column 9, lines 21-26).

Serra et al. do not disclose displaying the performance method.

However, Kellogg et al. disclose displaying performance parameters to be selected for varying a performance (figures 7A & 7B). Kakishita et al. disclose methods to be selected corresponding to each of the selected tone colors on a display, wherein one of the displayed performance methods can be selected (figures 3, 4, & 9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the teachings of Kellogg et al. and Kakishita et al. with the apparatus of Serra et al., because enhancement is provided, wherein the selection of performance methods can be made from a visual display.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlon T Fletcher whose telephone number is 703-308-0848. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Nappi can be reached on 703-308-3370. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Marion T Fletcher
Primary Examiner
Art Unit 2837

MTF
August 24, 2003